

REMARKS/ARGUMENTS

Claims 12-15 and 31 have been amended. New claims 39-40 have been added. Claims 12-18, 20, 22 and 29-40 are currently pending in this application.

Claims 12 and 31 have been amended to clarify that the step of sealing (step ii)) produces a sealed dispensing tip having a closed second end and defining a sample reservoir containing the sample. Steps iii) and iv) of claims 12 and 31 have been amended for consistency with the amendments made to step ii) of claims 12 and 31. Support for the amendments made to claims 12 and 31 is provided, for example, at page 7, lines 6 and 7-29; page 8, lines 6-9, and Figure 3.

Claims 13-15 have been amended to replace the term "sealable end" with the term —second end—.

New claims 39-40 have been added to further protect the invention of the present application. Support for new claims 39-40 is provided, for example, at page 7, lines 6-8.

Rejection Under 35 U.S.C. 112

Examiner has rejected claims 12-18, 20, 22 and 29-38 under 35 U.S.C. 112, second paragraph. Specifically, Examiner has asserted that step iii) of claim 12 is inconsistent with step iv), in the case where all of the fluid is aspirated in step iii). Applicant respectfully traverses Examiner's objection. It is respectfully pointed out that steps iii) and iv) are alternative steps rather than successive steps as Examiner has indicated. As a consequence, whether a portion or all of the fluid is aspirated from the sealed dispensing tip in step iii) has no bearing on step iv).

In view of the foregoing comments, Examiner is respectfully requested to withdraw the rejection to claims 12-18, 20, 22 and 29-38 under 35 U.S.C. 112, second paragraph.

Rejection Under 35 U.S.C. 102

Examiner has rejected claims 12-13 and 16 under 35 U.S.C. 102(e)(2) as allegedly lacking novelty in view of Juranas (U.S. Patent No. 6,368,872). Applicant respectfully traverses this rejection.

Applicant thanks Examiner for pointing the error with respect to summarizing the priority claim in the response dated February 1, 2005. The present application is a continuation-in-part application of serial No. 09/664,704. Applicant does not agree with Examiner that the subject matter of steps iii) and iv) of claim 12 is not supported by either application serial No. 60/078,780 and PCT/CA99/00236. However, this point is moot since, as argued below, Juranas does not anticipate the present invention.

In the Office Action dated July 14, 2004, Examiner asserted that steps i) to iii) of claim 12 read on the prior art system disclosed in Juranas, alleging that the sealing of dispensing tip 30 with sheath 18 or nozzle 22 followed by sample aspiration is equivalent to steps i) and ii) of claim 12, which are not specified as being conducted in a particular order. In addition, Examiner asserted that step iii) of claim 12 reads on the step of the prior art process described at column 3, line 52 to column 4, line 45 of Juranas, which according to Examiner discloses that sample is aspirated from the dispensing tip 30 into nozzle 22. Examiner also indicated that the method of steps i), ii) and iv) of claim 12 was free of the art.

Juranas discloses a prior art method of sample processing, comprising extending a nozzle 22 that is mounted within sheath 18, beyond the end of the sheath, to engage the upper end of a molded pipette tip 30 and mounting the pipette tip 30 onto nozzle 22 (see column 4, lines 15-19; FIGS. 2A and 2B). The mounted pipette tip 30 is next positioned over and lowered into a reagent contained in reservoir 32, and an amount of the reagent is suctioned into pipette tip 30 using an air pressure control source connected to nozzle 22 through tubing 26 (see column 4, lines 19-24 and 28-30). The mounted pipette tip containing the reagent is then positioned over a selected site on test grid 34, and the

reagent is then released into the site by applying air pressure through nozzle 22 (see column 4, lines 33-29).

In the Office Action dated July 14, 2004, Examiner alleged that since there is no requirement that steps i)-ii) of claim 12 be sequential, step ii) can be carried out before step i), and the combination of this sequence of steps would read on the sequential steps of the prior art method described in Juranas of sealing dispensing tip 30 with nozzle 22 and aspirating sample into dispensing tip 30. Applicant respectfully disagrees. Although Juranas describes that the upper inside of pipette tip 30 engages with the outer periphery of the end of nozzle 22 (see column 3, lines 63-66 and FIG. 2B) to form a seal, it does not disclose that this *sealed* pipette tip contains fluid, as recited in step ii) of claim 12. The method of Juranas requires that pipette tip 30 be sealably engaged with nozzle 22 prior to fluid being aspirated into pipette tip 30. This is very different to the step of sealing as defined within claim 12 where the second end of the dispensing tip that comprises fluid is sealed.

Juranas does not teach or suggest a step of sealing an end of a dispensing tip to produce a sealed dispensing tip having a *closed* end and defining a sample reservoir containing a fluid, as recited in amended claim 12. Rather, Juranas describes at column 3, lines 62-66, that nozzle 22 engages pipette tip 30, but does *not* teach that one of the ends of pipette tip 30 is sealed to form a *closed* end.

Furthermore, Juranus does not disclose a method that includes step iii) or iv), as recited in the presently pending claims. In particular, Juranus does not disclose a method that comprises a step of inserting a second dispensing tip into a sample reservoir of a sealed first pipette tip, which contains a fluid, and aspirating a portion or all of the fluid from the sample reservoir into the second pipette tip, or a step of withdrawing a diluent or reagent into a second pipette tip and dispensing the diluent or the reagent into the sample reservoir of the sealed first dispensing tip. At least for the reasons provided above, the presently pending claims are, therefore, novel over Juranus.

Based on the comments provided on page 2 of the Advisory Action dated December 16, 2004, Examiner appears to be of the opinion that the nozzle 22 of the prior art chemical sample processor 10, which is disclosed in Juranus, represents a pipette tip. Furthermore, Examiner appears to be of the opinion that in the operation of the prior art sample processor 10 fluid is drawn into the lumen of nozzle 22 from the pipette tip 30. It is respectfully submitted, however, that Examiner's interpretation of the operation of the processor 10 is incorrect. Although the nozzle 22 is similar in shape to the pipette tip 30, nozzle 22 is not a pipette tip, but is rather the terminal end of a pipette stem, which engages a pipette tip (column 4, lines 15-18).

In Juranus, fluid is not withdrawn into nozzle 22, as suggested by the Examiner, but is only suctioned into pipette tip 30. In addition, it is respectfully pointed out that withdrawal of fluid from the pipette tip 30 into the nozzle 22, as suggested by the Examiner, would defeat the whole purpose of the sample processor 10, which is to prevent cross contamination between different samples. For example, in column 4, lines 6-8 it is stated:

"As noted above, the disposal of used molded pipette tips is considered necessary to prevent cross contamination of chemicals."

And in column 4, lines 49-51 it is stated:

"As noted, the practice of discarding pipette tips is justified by the fundamental need to prevent contamination of chemicals."

Clearly, one of skill in the art would understand that if the disposable tip is removed to prevent cross contamination, then introduction of a sample within the nozzle itself would result in cross contamination and be contrary to the stated purpose of avoiding cross contamination when using the device.

In the Office Action dated May 19, 2005, Examiner indicated that in Applicant's response dated February 1, 2005, Applicant had referred to column 4, lines 15-18 as support for the assertion that withdrawal of fluid into nozzle 22 would potentially result in cross-contamination of chemicals. Applicant respectfully points out, however, that column 4, lines 6-8 of Juranus had been referred to in that response.

Accordingly, based on the foregoing comments, the presently pending claims are novel in view of Juranus, and Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. 102(e)(2).

It is respectfully submitted that the above-identified application is now in a condition for allowance and favorable reconsideration and prompt allowance of these claims are respectfully requested. Should the Examiner believe that anything further is desirable in order to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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